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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/732,815 | 12/11/2003 | Michel Bouvier | 2807-4 | 5882 |
| 23117 | 7590 | 08/05/2005 | EXAMINER | |
| NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203 | | | ULM, JOHN D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1649 | |

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/732,815

Applicant(s)

BOUVIER ET AL.

Examiner

John D. Ulm

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1649

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-22 is/are allowed.
- 6) ☒ Claim(s) 23-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/402,471.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/11/03, 5/7/04</u> . | 6) <input type="checkbox"/> Other: ____ |

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1) Claims 12 to 28 are pending in the instant application. Claims 1 to 11 have been canceled and claims 12 to 28 have been added as requested by Applicant in the correspondence filed 11 December of 2003.

2) The instant specification does not comply with 37 C.F.R. 1.77, which requires that:

(a) The elements of the application, if applicable, should appear in the following order:

- (1) Utility Application Transmittal Form.
- (2) Fee Transmittal Form.
- (3) Title of the invention; or an introductory portion stating the name, citizenship, and residence of the applicant, and the title of the invention.
- (4) Cross-reference to related applications.
- (5) Statement regarding federally sponsored research or development.
- (6) Reference to a ☐ Microfiche appendix ☐ (See 1.96 (c)). The total number of microfiche and total number of frames should be specified.
- (7) Background of the invention.
- (8) Brief summary of the invention.
- (9) Brief description of the several views of the drawing.
- (10) Detailed description of the invention.
- (11) Claim or claims.
- (12) Abstract of the Disclosure.
- (13) Drawings.
- (14) Executed oath or declaration.

(15) Sequence Listing (See. 1.821 through 1.825).

(b) The elements set forth in paragraphs (a)(3) through (a)(5), (a)(7) through (a)(12) and (a)(15) of this section should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading. [43 FR 20464, May 11, 1978; 46 FR 2612, Jan. 12, 1981; paras. (h) and (i), 48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; revised, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996].

Correction is required.

3) Claims 12 to 22 are allowable as written. As indicated in parent application 09/732,815, now Patent Number 6,713,276, the novel element of the invention disclosed in the instant application is reflected in the step of recovering the viral particles, because all of the other steps were practiced in the prior art in the same combination as they are employed in the instant invention, as exemplified by the Parker et al. publication (J. Biol. Chem. 266(1):519-527, 05 Jan. 1991). However, the prior art processes discarded the viral particles with the supernate at the time that the insect cells were harvested by low speed centrifugation. Because the prior art failed to disclose the presence of recombinant receptors on those viral particles, there was no motivation to recover them and employ them as a source of recombinant receptors.

4) Claims 23, 25 and 27 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 12. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being

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a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Each of claims 23, 25 and 27 differ from claim 12 only in a statement of intended use contained in the preamble. As stated in M.P.E.P. 2111.02, "If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir.1999).

5) Applicant is advised that should claim 24 be found allowable, claims 26 and 28 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6) Claims 24, 26 and 28 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 24, 26 and 28 fail to correspond in scope with that which applicant(s) regard as the invention can be found in lines 15 to 22 on page 3 of the instant specification, which states that "[t]he subject of the present invention is a

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method of producing a recombinant membrane receptor in a baculovirus/insect cell system, from a culture of insect cells infected with a recombinant baculovirus expressing the gene encoding the said membrane receptor, which method is characterized in that the said membrane receptor is obtained from extracellular baculoviruses produced by the said infected cells". The instant claims do not reflect the inventive concept stated in the specification because they do not require a "recombinant membrane receptor" nor do they recite that element or combination of elements needed to inherently produce a "recombinant" receptor. The limitation "recombinant baculovirus viral particles obtained from cells which express a membrane receptor" is not distinguishing because it is well established in the art that all viable cells express a plurality of membrane receptors and, therefore, meet the limitation "cells which express a membrane receptor". A baculovirus particle is "recombinant" if it contains any nucleic acid heterologous thereto irrespective of any protein encoded thereby.

7) Claims 23 to 28 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are the analytical step or steps that would be required to satisfy the preamble in any one of these claims. For example, claim 23 is drawn to a "method to study the properties of membrane receptors", but the recited claim elements contain no analytical steps. It is unclear how one can study something without measuring one or more parameters of the thing being studied. Claims 27 and 28 are each drawn to a "method of screening molecules which are active on membrane receptors" but the claims do not require a "molecule", a step

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mo of contacting that molecule with a receptor, or a step that measures the action of that molecule on that receptor.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

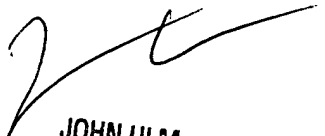
8) Claims 23 to 28 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, is inoperable and results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (571) 272-0880. The examiner can normally be reached on 9:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JOHN ULM
PRIMARY EXAMINER
GROUP 1600